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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/571,886	03/13/2006	Donald Robert Langdon	2003CH201	2678

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CLARIANT CORPORATION
INTELLECTUAL PROPERTY DEPARTMENT
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EXAMINER	
TAYLOR II, JAMES W	

ART UNIT	PAPER NUMBER
1796	

MAIL DATE	DELIVERY MODE
01/27/2009	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/571,886	LANGDON ET AL.	
	Examiner	Art Unit	
	James W. Taylor II	1796	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *02 October 2008*.

2a)☒ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-6 and 8-11* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-6 and 8-11* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

1. All outstanding claim rejections not explicitly maintained below are withdrawn in light of Applicant's amendment filed on 10/2/2008.

2. Text of those sections of Title 35, U.S. Code not included in this action can be found in a prior office action.

3. The new grounds of rejection set forth below are necessitated by Applicant's amendment filed on 10/2/2008. In particular, claim 1 has been amended to require that the metal sulfide is present in the material at a loading of 0.05 to 3 wt. % and that the binder is selected from a Markush group of binders. Contrary on the applicant's statement on page 4 of the amendment filed 10/2/2008, amended claim 1 contains not only the subject matter of canceled claim 7 but, in addition, contains a limitation imported from claims 9 with respect to the amount of metal sulfide. This combination has not previously been presented. Thus, the following action is properly made final.

Claim Rejections - 35 USC § 103

4. Claims 1-6 and 8-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hartman *et alli* (US 6,019,833).

5. Hartman teaches light colored conductive coating and associated processes (ti.). The binder for the composition is a saturated resin resin having pendent hydroxyl groups and an aminoplast curing agent, such as polyesters, polyurethanes, and ethylenically unsaturated monomers (c. 1, l. 65 to c. 2, l. 9). The composition further

comprises a light colored pigment that can be a mixture of multiple colored pigments (c. 2, ll. 38-45), which advantageously comprises a white and light colored pigment (c. 2, ll. 40-45). The light colored pigment can be *inter alia* zinc sulfide (c. 2, ll. 28-37). Other coloring pigments can be used, such as phthalocyanine blue or phthalocyanine green or metallic effect pigments, such as metal oxide encapsulated micas (c. 5, ll. 21 to 38).

6. Hartman fails to teach using 0.5 to 3.0 wt. % metal sulfide. Although Hartman teaches using 20 to 70 wt. % total light pigment (i.e., zinc sulfide and the white component), the reference is silent with respect to the ratio of zinc sulfide to white component. Further, one of ordinary skill in the art would have motivation to use less light colored pigment to change the aesthetic appearance of the final product (i.e., whiter with less color saturation). As such, ratio of zinc sulfide to white component is a result effective variable. Optimization of result effective variables through routine experimentation is not a patentable distinction. See *In re Beosch*, 617 F.2d 272, 205 USPQ 215 (CCPA 1980) and MPEP 2144.05 (II) (B). Therefore, it would have been obvious for one of ordinary skill in the art at the time of the invention to optimize the amount of zinc sulfide present in Hartman's invention to create a desired color.

7. Regarding claim 1, given that the above modification suggests creating similar composition to the present claims, the modification would innately be able to undergo laser marking.

8. Regarding claim 2, as noted above, the mica disclosed in Hartman is a metal-oxide encapsulated mica.

9. Regarding claim 3, the term "metal" refers to several elements from the s-block (except hydrogen), d-block, f-block, and the some of the s-block of the periodic table. Further, the three claimed metal oxides (i.e., antimony-, titanium-, and tin oxide) are all derived from known metal oxides. As such, one of ordinary skill in the art would understand that these three metal oxides are all established in the exclusive list of "metal oxides" disclosed in the prior art. See MPEP 2144.08 to species/genus relationships and MPEP 2144.09 for homolog/analog relationships. Therefore, it would have been obvious for one of ordinary skill in the art at the time of the invention to select antimony-, titanium-, and/or tin oxide as the metal oxide of Hartman.

10. Regarding claims 4-5, as noted above, the metal sulfide is zinc sulfide.

11. Regarding claims 6, 9, and 11, said other colored pigments (i.e., phthalocyanine blue, phthalocyanine green, and metal oxide coated mica) are cumulatively 0.5 to 25 wt. % of the composition. As such, there is an overlap in scope between the prior art and the instant claims. The claimed range would have been obvious to one having ordinary skill in the art at the time the invention was made, since it has been held that claiming an over lapping portion of the range taught in the prior is a *prima facie* case of obviousness. See *In re Malagari,* 182 USPQ 549 and MPEP 2144.05 (I). Further, one of ordinary skill in the art would understand that the loadings of these other colored pigments would, like the zinc sulfide above, directly control the resulting hue, saturation, and special effects in the case of metal oxide coated mica. As such, their concentrations are result effective variables. Optimization of result effective variables through routine experimentation is not a patentable distinction. See *In re Beosch*, 617

F.2d 272, 205 USPQ 215 (CCPA 1980) and MPEP 2144.05 (II) (B). Therefore, it would have been obvious for one of ordinary skill in the art at the time of the invention to optimize the amount of said other colored pigments present in Hartman's invention, including metal oxide coated mica, phthalocyanine blue, and phthalocyanine green, to create a desired color.

12. Regarding claim 8, the courts have stated that a chemical composition and its properties are inseparable. Therefore, if the prior art teaches the identical or substantially identical chemical structure and/or composition, the physical properties Applicant discloses and/or claims are necessarily present. See *In re Spada*, 911 F.2d 705, 15 USPQ2d 1655, (Fed. Cir. 1990). "Where the claimed and prior art products are identical or substantially identical in structure or composition, or are produced by identical or substantially identical processes, a *prima facie* case of either anticipation or obviousness has been established." *In re Best*, 562 F.2d 1252, 195 USPQ 430, (CCPA 1977). Further, if it is the applicant's position that this would not be the case, factual evidence would need to be provided to support the applicant's position.

Response to Arguments

13. Applicant's arguments with respect to claims 1-6 and 8-11 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

14. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

15. A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

16. Any inquiry concerning this communication or earlier communications from the examiner should be directed to James W. Taylor II whose telephone number is (571) 270-5457. The examiner can normally be reached on 7:30 am to 5:00 pm (off every other Friday).

17. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan can be reached on (571) 272-1119. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

18. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/James W Taylor II/
Examiner, Art Unit 1796

jwt2

/Vasu Jagannathan/
Supervisory Patent Examiner, Art Unit 1796